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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,636	10/28/2003	Mark A. Tapsak	DEXCOM.028A	5384
20995	7590	10/13/2006		
KNOBBE MARTENS OLSON & BEAR LLP				
2040 MAIN STREET				
FOURTEENTH FLOOR				
IRVINE, CA 92614				
			EXAMINER	
			MOORE, MARGARET G	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,636

Applicant(s)

TAPSAK ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 26, 135 to 139 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 26, 135 to 139 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/24/06 has been entered.
2. The disclosure is objected to because of the following informalities: Paragraph 265 refers to many US patent applications, the status of which have not been updated. Appropriate correction is required.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1 to 12, 17 to 26, 138 and 139 are rejected under 35 U.S.C. 102(e) as being anticipated by Kennedy.

This rejection relies on the rationale of record. Applicants' traversal that Kennedy doesn't recite that the silicone composition is configured to resist diffusion of an analyte is not persuasive. The Examiner bases this position on at least two points.

First note that the silicone composition claimed, one having a hydrophile grafted thereto and comprising a silicone polymer having alternating Si and O backbone with specific terminal groups, is the same as that taught in Kennedy et al. Products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. If applicants are of the position that the silicone compositions are, in fact, different and that this is why the composition in Kennedy et al. will not meet the claimed requirement, this difference should be reflected in the claims. As the claims stand now, however, the compositions are the same and it follows that the properties associated therewith are the same.

Second, note that the membrane in Kennedy et al. is permeable to water, hydrocarbons and oxygen. If the membrane was permeable to other substances patentees would have noted this. Since patentees only discuss permeability to water, oxygen and hydrocarbons, this indicates that the membrane is not permeable to everything. To this extent note column 4, line 13, which indicates that the membranes are semipermeable. The term "analyte" is extremely broad can be considered to encompass anything. Obviously the membrane of Kennedy et al., which is specifically permeable to water, hydrocarbons and oxygen, will not be permeable to everything. In view of the breadth of this limitation, this is inherently met by the membrane in Kennedy. (The Examiner notes that this argument does not apply to claim 139; from claim 139, please note the preceding paragraph.)

5. Claims 1 to 26 and 135 to 139 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Antwerp.

The teachings of Van Antwerp were addressed in previous office actions. Applicants addressed Van Antwerp as it would apply to the newly amended claims in their reply. They argued that Van Antwerp does not teach the terminal groups as claimed. Applicants have apparently overlooked the fact that the terminal groups claimed can be substituted. This opens the claimed terminal group such that they could be alkyl groups substituted by polyurethane groups. For instance paragraph 201 in the specification indicates that they can be substituted with isocyanate crosslinking groups, the same groups that form the polyurethanes. In view of the term "substituted", Van Antwerp discloses a silicone polymer as now claimed.

For claim 135, see Table 2. For claim 136, see the specifically delineated upper value of 200 on column 5, lines 50 to 60.

6. Claims 1 to 5, 7, 8, 10, 11, 17 to 19, 138 and 139 are rejected under 35 U.S.C. 102(e) as being anticipated by Al-Lamee.

7. Claims 13 to 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Al-Lamee.

The teachings of Al-Lamee have been addressed in previous office actions. These rejections rely on the rationale of record and as such this will not be repeated. Applicants' traversal, that patentees do not teach the "controls transport of an analyte" is not persuasive for at least two reasons.

First, consistent with that noted above in the Kennedy rejection, note that the silicone composition that forms the membrane in Al-Lamee meets that claimed. As such the properties associated therewith must also be the same.

Second, note column 2, lines 20 and on. The membrane in Al-Lamee is configured to bind negatively charged molecules such as heparin. This membrane will not allow heparin to diffuse. Since "analyte" includes heparin, this meets the limitation found in claim 1.

8. Claims 1 to 12, 17, 19 to 26, 138 and 139 are rejected under 35 U.S.C. 102(b) as being anticipated by Keogh et al.

This rejection also relies on the rationale of record.

As noted above, chemical compositions and their properties are inseparable. Since the membrane in Keogh et al. meets the requirement of the silicone composition that comprises the claimed membrane, it would appear to inherently have the same properties as the claimed membrane. Again, if applicants are of the position that the silicone membrane in the prior art does not have the same properties as that claimed because they are chemically different, this should be reflected by the claim language.

9. In conclusion, the Examiner notes the two following points. First, the discovery of a previously unappreciated property of a prior art composition does not render the old composition patentably new to the discoverer. Thus, while the prior art might not use the language "resist diffusion of an analyte" per se, this does not on its own lend patentability to an otherwise known membrane. Second, note that once a reference teaching a product appearing to be substantially identical as that claimed is applied as the basis of a rejection, the burden of proof shifts to applicants to show that the prior art products do not necessarily possess the characteristics of the claimed product. The Examiner

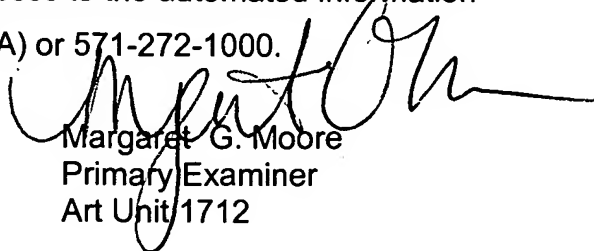
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has provided a reasonable basis for the position that the property claimed will be found in the prior art (i.e. that the chemical compositions of the membranes are the same). As a result, arguments that the property is not taught by the prior art references are not sufficient to overcome this rejection.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
10/10/06